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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/870,178

05/29/2001

Steven Sims

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7266

996

7590

07/23/2002

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EXAMINER

ROSENTHAL, DANIELLE S

ART UNIT

PAPER NUMBER

3644

DATE MAILED: 07/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>
	09/870,178		SIMS, STEVEN
	<b>Examiner</b>	<b>Art Unit</b>	
	Danielle S. Rosenthal	3644	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 5, 10 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-19 and 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Species II in Paper No. 10 is acknowledged. Species II encompasses claims 1-4, 6-9, 11-19 and 21-34.

***Drawings***

2. The drawings are objected to because in Fig. 3, it is unclear what "52" is pointing to. It appears that "52" is referencing the same object as "26". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to because in Fig. 10 it appears "123" should be changed to "173". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "46" on page 8, lines 1 & 16; "175" on page 15, line 15; "176" on page 16, line 1; cavities "106 & 108" on page 11. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

5. The disclosure is objected to because: reference character "40" has been used to designate both a sidewall on page 8, line 3 and a tab on page 7, line 17; reference character "84" has been used to designate both a head on page 9, line 20 and a recess on page 9, line 14; reference character "86" has been used to designate both a head on page 9, line 20 and an axis on page 9, line 21; reference character "92" has been used to designate both an adhesive on page 10, line 21 and an arrow on page 10, line 8; reference character "124" has been used to designate both a pad on page 14, line 22 and a gunstock on page 14, line 21; reference character "196" has been used to designate both a sleeve on page 16, line 18 and a decay modifier on page 16, line 9.

Appropriate correction is required.

6. The disclosure is objected to because reference characters "65" and "64" have both been used to designate a round head on page 9, lines 4 & 13 but there is no "64" in the drawings; reference characters "194" and "198" have both been used to designate a pad on page 16, line 2 and line 9. Appropriate correction is required.

7. The disclosure is objected to because of the following informalities: page 14, line 14, fasteners "136 & 136" should be changed to --fasteners 134 & 136--.

Appropriate correction is required.

8. The disclosure is objected to because they include the following reference sign(s) not mentioned in the description: "160" in Fig. 6; "201" in Fig. 13; "203" in Fig. 14. A proposed drawing correction, corrected drawings, or amendment to the specification to

add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application.

9. The disclosure is objected to because of the following informalities: page 13, line 9 "138 & 140" are called heads of the mushrooms but in Fig. 7 these characters point to the heads of the screws.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3-4, 6-9, 11-12, 15-19, 21-23, 25, 28-29, 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (4,922,641). Regarding claims 1, 3, 28 and 29, Johnson discloses an accessory for reducing the kick felt by a shooter comprising: a pad 62, 64, 66 with a cavity, a rigid plate 40 which is configured to complement the configuration of a specific firearm stock, and a vibration decay pattern modifier 50; said pad and said decay fabricated from elastomeric material. Note that a spring is malleable and is thus elastomeric. Further the pad is foam, which is an elastomeric material. Said pad comprising an aperture opening 82 onto a face of the pad; said plate being assembled in face-to-face relationship with that face of the pad (Johnson, Fig. 2); the decay pattern having a first element integrated with the plate and

a second element which is integral with the first element and is disposed in the aperture in the elastomeric pad (Johnson, Fig. 2).

12. Regarding claim 4 and the aforesaid discussion on claim 1, Johnson discloses the claimed invention wherein the plate is configured to extend beyond the perimeters of a variety of gunstocks and machinable to match the perimeter of the plate to the perimeter of a particular firearm stock.

13. Regarding claims 6-8 and the aforesaid discussion on claim 1, Johnson discloses the claimed invention wherein the firearm has a stock 10; and threaded fasteners (Johnson, Fig. 3) for maintaining the pad and the plate in an assembled relationship and mounting the accessory to the stock of the firearm.

14. Regarding claim 9 and the aforesaid discussion on claim 8, Johnson discloses the claimed invention which includes a rigid mounting plate (Fig. 3, 66), said mounting plate embedded in said pad and providing a mechanism for supporting the threaded fastener.

15. Regarding claims 11,12 and the aforesaid discussion on claim 1, Johnson discloses the claimed invention wherein the pad aperture in which the second element of the modifier is disposed is so sealed that said pad provides a pneumatic cushioning and wherein there is clearance around the periphery of the second modifier.

16. Regarding claims 15,18,19 and the aforesaid discussion on claim 1, Johnson discloses the claimed invention in which the pad has the capability of elastically compressing.

17. Regarding claim 16 and the aforesaid discussion on claim 15, Johnson discloses the claimed invention which there are cavities in the pad.

18. Regarding claim 17 and the aforesaid discussion on claim 1, Johnson discloses the claimed invention wherein the material from which the pad is fabricated has properties which make the pad capable of modifying the decay pattern.

19. Regarding claims 21,22 and the aforesaid discussion on claim 17, Johnson discloses the claimed invention in which said cavity reduces the thickness of the accessory material and in which there is an additional cavity in said pad (Johnson, Fig. 3)

20. Regarding claim 23 and the aforesaid discussion on claim 21, Johnson discloses the claimed invention in which said cavity extends completely through said pad and accommodates a fastener (Fig. 3).

21. Regarding claim 25 and the aforesaid discussion on claim 23, Johnson discloses the claimed invention in which there is a clearance around the periphery of the modifier head.

22. Regarding claim 32 and the aforesaid discussion on claim 28, Johnson discloses the claimed invention in which the elastomeric pad is hollowed out. Note that the cavities in the pad effectively provide a hollowed out portion in the pad.

23. Regarding claim 33 and the aforesaid discussion on claim 32, Johnson discloses the claimed invention which comprises a component for modifying the decay pattern of the vibrations 50; said component disposed in said cavity of the pad (Fig. 3), said cavity being one of the features which hollow out said pad.

24. Regarding claim 34 and the aforesaid discussion on claim 33, Johnson discloses the claimed invention which includes an additional cavity in said pad which contributes to hollowing of said pad (Fig. 3), fastener and cavity between segments of accessory aperture.

***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 2 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Sims (5,362,046). Regarding claims 2 and 24 and the aforesaid discussion on claims 1 and 17, Johnson discloses the claimed invention but does not expressly disclose a mushroom-like configuration for the decay pattern modifier. Sims discloses in an analogous art a decay pattern modifier 32 with a mushroom configuration (Sims, fig. 4). It would have been obvious to one having ordinary skill in the art to modify Johnson to include the mushroom-like configuration for the decay modifier. The motivation for doing so would have been to provide a more effective and lightweight damping device as taught by Sims.

27. Claims 13,14,26,27,30,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson. Regarding claims 13,14,26,27,30,31 and the aforesaid discussion on claims 1,17,22, Johnson discloses the claimed invention except for



expressly disclosing the claimed materials with specific specifications for the pad and modifier. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use this material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 284 (CCPA 1954).

### ***Conclusion***

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tredway et al. (490,129), Ringsmith (1,213,951), Wagoner (1,328,700), Amman (1,805,273), Vatterott (5,375,360) disclose related pads for gun stocks.

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle S. Rosenthal whose telephone number is (703) 305-2765. The examiner can normally be reached on M-Th & every other F, 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan can be reached on (703) 308-2484. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*Charles T. Jordan*  
CHARLES T. JORDAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

Danielle S. Rosenthal *DSR*  
Examiner  
Art Unit 3644

July 17, 2002